



Docket No: AM101194  
Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re of Application of: **CHIARELLO, John F. et al**

Application No.: **10/716,649** Group Art No.: **1626**  
Filed: **November 19, 2003** Examiner: **Laura L. Stockton, Ph.D.**  
For: **N-PHENYL-3-CYCLOPROPYLPYRAZOLE-4-CARBONITRILES AS  
ECTOPARASITICIDAL AGENTS**  
Confirmation No.: **7650**  
Customer Number: **25291**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

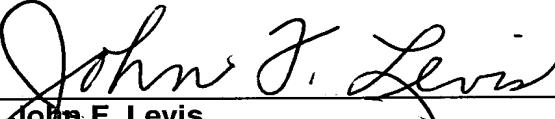
Enclosed please find the following documents for the above-identified application:

**1. Response to Restriction Requirement.**

No fee is believed due with this Transmittal.

However, the Commissioner is hereby authorized to charge any additional fees required by this paper, including the enclosed documents, and during the entire pendency of this application and to credit any excess amounts paid to Deposit Account No. 01-1425. A copy of this letter for use by the PTO is enclosed.

Respectfully submitted,

  
**John F. Levis**  
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**CERTIFICATE OF MAILING 37 CFR §1.10**

I hereby certify that this paper and the documents referred to as enclosed therein are being deposited with the United States Postal Service on the date written below in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number EV100498570 US addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

November 22, 2004  
Date

Patricia A. Kosiak  
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11-23-04

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RESPONSE TO RESTRICTION REQUIREMENT

In response to the Official Action mailed November 1, 2004, applicants hereby elect, Group I, Claims 1-10 and 20-30, without traverse, for further prosecution in the application. Group II, Claims 11-19, will likely be pursued in a separate, divisional application.

Applicants also provisionally elect, with traverse, the compound of Example 29 in Table I on page 17 of the application. This compound is identified in the specification and claims as 5-bromo-3-(2,2-dichloro-1-methylcyclopropyl)-1-[2,6-dichloro-4-(trifluoromethyl)phenyl]-1H-pyrazole-4-carbonitrile.

Applicants also respectfully request reconsideration of the requirement for restriction of the individual species set forth above. In order for restriction to be proper, the claimed inventions must be independent or distinct for searching purposes. Thus, according to MPEP §802.01, there should not be at least some disclosed relation between any of the individual species. In the instant case, all the recited species are members of the family of compounds identified by the structure of formula I, and this is amply set forth in the specification and claims. Thus, the Office can search on the general compound identified by the structure provided, and this should not present a significant searching issue in terms of either time or expense.

In addition, MPEP §806.04(f) sets forth that claims to be restricted to different species must be mutually exclusive:

*The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.*

In the present application, this situation does not exist. There are no claims in which limitations are recited that are found in only one species, and not the others. All the species in all the claims do have at least some significant structure in common.

Applicants do not concede that the individual species are not patentably distinct, or are obvious variants of one another. They do maintain, however, that all species can be searched by the Office without a burdensome effort. By focusing on the common structural elements of the claimed compounds, an effective search can be undertaken.

Based on the foregoing, applicants respectfully request withdrawal of the restriction requirement as to the individual species of compound.

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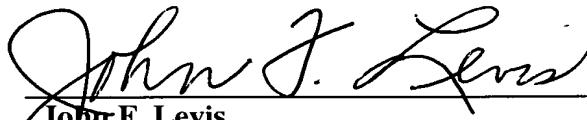
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November 22, 2004  
Date

Patricia A. Kosiak  
Patricia A. Kosiak

The application is believed to be in condition for allowance, and prompt, favorable action thereon is earnestly solicited. Should Examiner Stockton feel that any other point requires consideration, then she is cordially invited to contact the undersigned.

Respectfully submitted,



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